

## REMARKS

Reconsideration of the above-identified application in view of the amendment above and the remarks below is respectfully requested.

No claims have been canceled or added in this paper. Claim 1 has been amended in this paper. Therefore, claims 1-4 and 24-35 are pending and under active consideration.

The drawings stand objected to under 37 CFR 1.83(a) for the following reason:

The drawings must show every feature of the invention specified in the claims. Therefore, the “chamber being in a container” in claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

In response to the above, Applicant notes that claim 1 has been amended so that the language in question is no longer recited. Therefore, the objection is moot and should be withdrawn.

Claims 1-4 and 24-35 stand rejected under 35 U.S.C. 112, first paragraph, “as failing to comply with the written description requirement.” In support of the rejection, the Patent Office states the following:

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 now recites “said chamber being in a container”. Applicant’s specification defines “the chamber” as element 16 in which the image recording device 30 and scanner 29 are accommodated (see for example page 7, lines 9-12). The container 20 is defined as containing body fluid 21 (see for example page 6, lines 18-32). There is no support in the instant specification (including the figures) for the “chamber 16 being in a container”. Nor has Applicant pointed out where support for such a configuration can be found in the specification and/or figures.

In addition, the Examiner cannot locate support for the chamber being in a container and with no optical reflections as recited in claim 3.

Applicant respectfully traverses the subject rejection. The subject rejection appears to be predicated, in large part, on the fact that claim 1 recites “said chamber being in a container.” However, as noted above, this language is no longer recited in claim 1. Therefore, this ground in support of the rejection is no longer applicable.

In addition, to the extent that the subject rejection is based on the fact that claim 3 recites that the container has no optical reflections, Applicant respectfully submits that the present specification, for example, on page 7, lines 7-9 (e.g., inner walls having matte black surfaces), provides ample support for this feature.

Accordingly, for at least the above reasons, the subject rejection should be withdrawn.

Claims 1-4 and 24-35 stand rejected under 35 U.S.C. 112, second paragraph, “as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” In support of the rejection, the Patent Office states the following:

Claim 1 now recites “said chamber being in a container”. This is confusing and indefinite. As discussed above, the specification defines “the chamber” as element 16 in which the image recording device 30 and scanner 29 are accommodated (see for example page 7, lines 9-12). The container 20 is defined as containing body fluid 21 (see for example page 6, lines 18-32). As discussed above, there is no support for the “chamber being in a container” in the specification and/or figures. Thus, it is not clear what “chamber” Applicant is referring to in claims 1 and 3. For the same reasons discussed above, it is not clear how the chamber inside the container has not optical reflections as recited in claim 3. For purposes of examination, the body fluid will be interpreted as being provided in a container.

Claim 1 also lacks any transitional phrase (e.g., comprising, consisting essentially of, and consisting of) that separates the claim preamble and body of the claim. Transitional phrases define the

scope of the claim with respect to what unrecited additional components or steps, if any, are excluded from the scope of the claim. As presently written it appears the claim is directed to the illuminating device. The “chamber”, “container”, “image recording device” and “electronic image evaluation apparatus” are not positively recited elements of the claim. For purposes of examination, the claim has been interpreted to be directed solely to the particular arrangement of the illuminating device.

Applicant respectfully traverses the subject rejection. With respect to the first ground given in support of the rejection, as noted above, the language “said chamber being in a container” is no longer recited in the claim. Also, with respect to claim 3, Applicant respectfully submits that a person of ordinary skill in the art, after having read the present specification, would understand what is meant by a chamber with no optical reflections. Moreover, as noted above, the specification provides at least one arrangement for achieving a chamber with no optical reflections, namely, by providing inner walls having matte black surfaces (see the present specification, for example, on page 7, lines 7-9).

Finally, with respect to the Patent Office’s remarks regarding the inclusion of a transitional phrase in claim 1, Applicant has amended claim 1 so that the transitional term “comprising” is included. In addition, Applicant has amended claim 1 so that, amongst other things, “chamber,” “container,” “image recording device” and “electronic image evaluation apparatus” are positively recited.

Accordingly, for at least the above reasons, the subject rejection should be withdrawn.

Claims 1-4 and 24-35 stand rejected under 35 U.S.C. 112, second paragraph, “as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.” In support

of the rejection, the Patent Office states that “[t]he omitted structural cooperative relationships are: between the ‘image recording device’ and the ‘illuminating device’. It is not clear how these two elements are related.”

Applicant respectfully traverses the subject rejection. As herein amended, claim 1 recites that the illuminating device serves to illuminate the container and recites that the image recording device serves to produce at least one image of the body fluid in the container. Consequently, claim 1 clearly sets forth the relationship between the image recording device and the illuminating device.

Accordingly, for at least the above reasons, the subject rejection should be withdrawn.

Claims 1-4, 25, 27, 29 and 34 stand rejected under 35 U.S.C. 102(b) “as being anticipated by Russell (US Patent No. 5,012,116).” In support of the rejection, the Patent Office states the following:

Russell teaches an arrangement for analyzing items (i.e., ball bearings 202) using an illumination device arranged above and illuminating an item (i.e., light diffusing cylindrical tube 204). Note that the container (and chambers) are not positively recited elements of the claim and therefore, do not patentably distinguish the device. Therefore, the ball bearings 202 of Russell read on the container and chamber.

The illumination device of Russell includes two lateral lamps 222a,b and a middle lamp 222c. The two lateral lamps are disposed on each side of the container such that the mid-points of the two lamps and the mid point of the container lie on a straight line (see horizontal line in Fig. 2a). The middle lamp 222c is disposed in such a way that the mid point of the middle lamp and the container lie on a straight line see vertical line in Fig. 2a, which is perpendicular to the straight line the horizontal line.

Note although, not positively recited in the instant claims, Russell also teaches an image-recording device 120 (video camera 218a) see Fig. 2a.

Regarding claim 29, the other video camera 218b in Fig. 2a reads on a “scanner”, since Russell teaches one of the image-recording devices can be a scanning video camera (see col. 4, lines 44-49).

As to claim 34, Russell also teaches a handling apparatus 200a,b (track rails) for moving a container from its transportation position (hopper 208) to its analysis position shown in Fig. 2a.

Applicant respectfully traverses the subject rejection. Claim 1 has been amended in this paper and now recites “[a]n arrangement for analyzing body fluids comprising an image recording device, an electronic image evaluation apparatus, a container, a chamber, and an illuminating device, the image recording device being connected to the electronic image evaluation apparatus, wherein the body fluid is provided in the container, the container being in the chamber, the chamber having few optical reflections, the image recording device serving to produce at least one image of the body fluid in the container and being aligned with and focused on the container, which is in a stationary analysis position, the illuminating device being arranged above the container, wherein the illuminating device serves to illuminate the container, the illuminating device comprising on each of two sides of the container located in the stationary analysis position a lateral lamp, the lateral lamps being arranged such that the mid points of the two lateral lamps and the mid point of the container lie on a straight line (A), the illuminating device further comprising a further, middle lamp being provided and arranged in such a way that the mid points of this middle lamp and of the container likewise lie on a straight line (B), which runs perpendicular to the straight line (A).”

Russell neither teaches nor suggests the arrangement of claim 1. First of all, Applicant notes that claim 1 has been amended in this paper so that the container and the chamber are positively

recited. The ball bearing of Russell does not teach or suggest a container for holding a body fluid, the container being in a chamber.

More specifically, claim 1 is patentably distinguishable over Russell because Russell is limited to teaching an apparatus for analyzing the mirror-like convex surface of a bearing ball. This means that the requirements, as well as the mechanisms necessary to carry out this kind of analysis, are completely different from the present invention. As disclosed in Fig. 1 of Russell, Russell is based on the fact that light is reflected by the convex surface of the bearing ball and that defects of the surface result in a disturbance of this reflection phenomenon (see Russell at col. 5, lines 13-45). By contrast, the present invention requires a chamber with few, preferably no optical reflections, since such reflections would render the analysis of body fluids impossible.

With regard to Fig. 2a of Russell, Russell teaches the use of a light-diffusing cylindrical tube 204 (see Russell at col. 6, line 25), which is contrary to the claimed chamber with few optical reflections. The light emitted by the light sources 222a, 222b, 222c passes through the light diffusing tube 204, which, therefore, must be transparent since no apertures assigned to the light sources 222a, 222b, 222c are disclosed. The light is thoroughly diffused over the length of tube 204 (see Russell at col. 7 line 66 through col. 8, line 8). The bearing ball 202 is moved through tube 204, its surface reflecting the diffused light. The reflections passing two small apertures 216a, 216b are detected by video cameras 218a, 218b (see Russell at col. 7, lines 32-65).

Accordingly, for at least the above reasons, the subject rejection should be withdrawn.

Claims 1-4, 24-25, 27 and 29 stand rejected under 35 U.S.C. 102(e) “as being anticipated by Chandler (US Patent No. 6,139,800).” In support of the rejection, the Patent Office states the following:

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Chandler teaches an apparatus for use in assays. The apparatus includes a lateral lamp 12, 16 arranged on both sides of a container 1 (see Fig. 4). The arrangement being such that the mid-points of the two lamps and the mid-point of the container lie on a straight line (A). See figure 4 of Chandler. Furthermore, a middle lamp 14 is provided and arranged in such a way that the mid points of this middle lamp and of the container, likewise, lie on a straight line (B), which runs perpendicular to the line (A).

With respect to claims 24-25, Chandler teaches the optical axis of the image recording device 10 runs in a vertical plane that is perpendicular to the line (A). The line (B) lies in this vertical plane, see Fig. 4. Please note that Chandler teaches that laser diodes are preferred, however, other optical sources/detectors are suitable.

Regarding claim 29, one of the optical detectors 20, 22, reads on a “scanner”, since optical detectors can be used to scan an item.

Applicant respectfully traverses the rejection. Chandler discloses the detection of receptors in a biological sample in a flow stream (i.e., moved during detection) for immunoassays. The Chandler method and apparatus requires an indicator, such as a fluorescent dye. The light sources serve for activating light emission of any kind by the indicator. The detectors serve for detecting said light emission (see Chandler at col. 3, lines 56-65; col. 8, line 51 through col. 9, line 40). Therefore, Chandler does not teach or suggest beams of light that are illuminating a body fluid provided in a container which is not moved (i.e., stationary) during detection nor does it teach or suggest an image recording device detecting an image of the body fluid.

Accordingly, for at least the above reasons, the subject rejection should be withdrawn.

Claims 26 and 28 stand rejected under 35 U.S.C. 103(a) “as being unpatentable over Russell (US Patent No. 5,012,116) or Chandler (US Patent No. 6,139,800).” In support of the rejection, the Patent Office states the following:

The teachings of Russell and Chandler have [been] summarized previously, *supra*. Neither Russell or Chandler specifically recite the spacing of each lamp from the container being sixty millimeters (claim 26) or the difference in height between the lateral lamps and the middle lamp is sixteen millimeters (claim 28).

However, it would have been an obvious matter of design choice to make the spacing between each lamp from the container sixty millimeters and the difference in height between the lateral lamps and the middle lamp sixteen millimeters in either the system of Russell or Chandler, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Applicant respectfully traverses the subject rejection. The deficiencies of Russell and Chandler have been discussed above. Applicant respectfully submits that neither Russell nor Chandler would have taught or suggested the subject matter of claims 26 and 28 to a person of ordinary skill in the art.

Accordingly, for at least the above reasons, the subject rejection should be withdrawn.

Claim 30 stands rejected under 35 U.S.C. 103(a) “as being unpatentable over Russell (US Patent No. 5,012,116) or Chandler (US Patent No. 6,139,800), in view of Watson et al. (WO 99/28724), hereinafter Watson.”

Applicant respectfully traverses the subject rejection. Claim 30 depends ultimately from claim 1. Claim 1 is patentable over Russell or Chandler for at least the reasons given above. Watson fails to cure all of the deficiencies of Russell or Chandler with respect to claim 1. Moreover,



Applicant respectfully submits that there would have been no reason for a person of ordinary skill in the art to have combined the references in the manner suggested by the Patent Office. Therefore, based at least on its dependency from claim 1, claim 30 is patentable over the applied combination of references.

Accordingly, for at least the above reasons, the subject rejection should be withdrawn.

Claims 31-33 stand rejected under 35 U.S.C. 103(a) “as being unpatentable over Russell (US Patent No. 5,012,116) or Chandler (US Patent No. 6,139,800), in view of Toshiaki (JP 09-133687).”

Applicant respectfully traverses the subject rejection. Claims 31-33 depend ultimately from claim 1. Claim 1 is patentable over Russell or Chandler for at least the reasons given above. Toshiaki fails to cure all of the deficiencies of Russell or Chandler with respect to claim 1. Moreover, Applicant respectfully submits that there would have been no reason for a person of ordinary skill in the art to have combined the references in the manner suggested by the Patent Office. Therefore, based at least on their respective dependencies from claim 1, claims 31-33 are patentable over the applied combination of references.

Accordingly, for at least the above reasons, the subject rejection should be withdrawn.

Claim 35 stands rejected under 35 U.S.C. 103(a) “as being unpatentable over Russell (US Patent No. 5,012,116) in view of Watson et al. (WO 99/28724), hereinafter Watson.”

Applicant respectfully traverses the subject rejection. Claim 35 depends ultimately from claim 1. Claim 1 is patentable over Russell for at least the reasons given above. Watson fails to cure all of the deficiencies of Russell with respect to claim 1. Moreover, Applicant respectfully submits that there would have been no reason for a person of ordinary skill in the art to have combined the

references in the manner suggested by the Patent Office. Therefore, based at least on its dependency from claim 1, claim 35 is patentable over the applied combination of references.

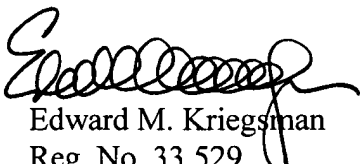
Accordingly, for at least the above reasons, the subject rejection should be withdrawn.

It is respectfully submitted that the present application is now in condition for allowance. Prompt and favorable action is earnestly solicited.

If there are any fees due in connection with the filing of this paper that are not accounted for, the Examiner is authorized to charge the fees to our Deposit Account No. 11-1755. If a fee is required for an extension of time under 37 C.F.R. 1.136 that is not accounted for already, such an extension of time is requested and the fee should also be charged to our Deposit Account.

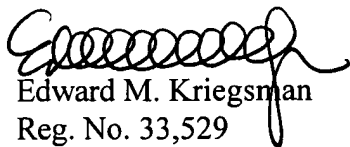
Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 10, 2008

  
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